

## **REMARKS**

Claims 16-41 are pending. The formulation of claim 16 has been amended from “comprising” to “consisting essentially of”. Support may be found in the specification generally and specifically on page 8. No statutory new matter has been added. Reconsideration and entry of the amendment are respectfully requested.

### **Rejection Under 35 U.S.C. §112, first paragraph**

The Examiner rejected claims 40-41 under 35 U.S.C. 112, first paragraph, as containing subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use this invention. Specifically, the Examiner deemed that the claims were directed to a formulation for use in therapy of certain diseases and disorders without any evidence of a response to EFA treatment.

Applicants respectfully submit that most of the diseases and disorders as recited in the claims are responsive to EFA treatment. In support, Applicants submit herewith a Declaration by David Horrobin (an inventor of the present invention and expert in the field) and journal articles cited therein and the curriculum vitae of David Horrobin. As provided in the Declaration, Dr. Horrobin explains that EFAs are shown to be effective in methods of treating and preventing the various diseases provided in the present claims. Specifically, Dr. Horrobin provides examples which set forth the fact that the administration of EFAs are accepted treatments for a variety of cardiovascular diseases, diabetes, psychiatric diseases and disorders, neurological diseases and disorders, kidney disease, inflammatory and immunological disorders, eye diseases and hearing disorders, obesity, and cancer.

Applicants discovered the synergistic effect of the combination of at least one EFA and at least one homocysteine lowering agent and understood that homocysteine destroys EFAs by promoting its oxidation. Thus, Applicants conceived of the methods and formulations of the present invention, which are directed to the combination of at least one EFA and at least one homocysteine lowering agent. The methods and formulations of the present invention are based on the fact any disease or disorder showing a response to EFA treatment alone should also be responsive to the combination of at least one EFA and at least one homocysteine lowering agent.

Applicants submit that nowhere has the Examiner provided any evidence, reason, or logical explanation why various diseases showing a response to EFA treatment will not be responsive to the combination of at least one EFA and at least one homocysteine lowering agent. Additionally, Applicants respectfully point out that the presence of inoperative embodiments within the scope of a claim does not render the claim nonenabled. See MPEP 2164.08(b). All that is required is that one of ordinary skill in the art would be able to determine which embodiments are operative or inoperative with no more effort normally required in the art. See *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984).

Applicants respectfully submit that one of ordinary skill in the art need only conduct small clinical trials to determine whether the combination therapy of the present invention is efficacious against a given disease or disorder. Applicants submit that clinical efficacy studies are not undue experimentation as the clinical efficacy studies are normally required in the art. If clinical efficacy studies were required for enablement, no one in the pharmaceutical arts would be granted a patent prior to conducting clinical efficacy studies required by the U.S. Food and

Drug Administration. Clearly, a review of many issued patents in the pharmaceutical arts evidence that the lack of human clinical trials does not render the claims nonenabled.

As the Examiner has not provided any reasoning or evidence to establish that the claims of the present invention are nonenabled, the rejection under 35 U.S.C. 112, first paragraph, should properly be withdrawn.

Additionally, claims 16-41 were rejected under 35 U.S.C. 112, first paragraph, because the Examiner deemed that the specification does not reasonably provide enablement for a compound related to folic acid with similar biological activity.

Again, Applicants respectfully submit that compounds related to folic acid having similar biological activity are fully enabled. Specifically, one of ordinary skill in the art may readily determine what compounds may be used to alleviate folic acid deficiency by conventional methods in the art. For example, one of ordinary skill in the art need only select a compound that is known to alleviate folic acid deficiencies in order to practice the present invention as claimed. No undue experimentation is required.

Nevertheless, in order to advance prosecution, the claims have been amended to cancel the offending phrase. Therefore, Applicants respectfully submit that the rejection under 35 U.S.C. 112, first paragraph, may properly be withdrawn.

#### **Rejection Under 35 U.S.C. §§102(b) /103(a)**

The Examiner rejected claims 16-41 under 35 U.S.C. §102(b) as anticipated or 35 U.S.C. §103(a) as being obvious over EP 0,305,097, EP 0,198,804, or WO 99/03482. Specifically, the Examiner deemed that the claims included the term “comprising” and therefore the formulations were open-ended and encompass additional compounds including those of the prior art.

Applicants respectfully submit that the claims as previously amended limited the claims to formulations having “no significant amounts of other micronutrients”. As it appeared that the Examiner did not give the limitation any patentable weight, Applicants telephoned the Examiner on April 22, 2002, to discuss. The Examiner confirmed that the limitation was overlooked and that the anticipation rejection may be overcome by the limitation.

Nevertheless, Applicants have amended the claims such that the formulations do not include other agents or micronutrients that will “materially affect the basic and novel characteristic(s)” of the claimed formulations by changing the term “comprising” to “consisting essentially of” in the preamble. *See In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA).

Again, Applicants respectfully submit that none of the prior art, alone or in combination, teach or suggest the present invention as claimed -- a formulation consisting essentially of EFAs and homo-cysteine lowering agents. The present invention as claimed makes clear that the formulation does not include significant amounts of other micronutrients as provided in the specification on page 8.

As none of the prior art cited by the Examiner, alone or in combination, teach each and every element of the present invention as claimed, the rejection under 35 U.S.C. 102(b) may be properly withdrawn.

Applicants respectfully submit that the invention as claimed is nonobvious. Specifically, as provided in the Declaration of David Horrobin, the combination of at least one EFA and at least one homocysteine-lowering agent in the absence of significant amounts of other micronutrients provides unexpected synergistic results. In his Declaration, Dr. Horrobin explains the results of two scientific journal articles, which were published after the effective filing date

of the present application. The results of the journal articles evidence that the administration of EPA and DHA in combination provide a synergistic biological response that is greater than the response of each alone and the sum thereof.

As none of the prior art references cited by the Examiner teach or suggest the synergistic response of the combination of at least one EFA and at least one homocysteine-lowering agent, the present invention as claimed is nonobvious and the rejection under 35 U.S.C. 103(a) should be withdrawn.

#### **Extension of Time**

A Petition for an Extension of Time for three months under 37 C.F.R. §1.136 and the appropriate fee has been filed to extend the due date for responding to the Official Action to May 23, 2002.

### CONCLUSION

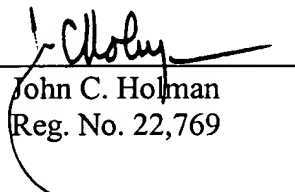
Accordingly, in view of the foregoing amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims to allow these claims and to find this application to be in allowable condition.

If the Examiner believes that a conference would be of value in expediting the prosecution of this application, the Examiner is invited to telephone the undersigned to arrange for such a conference.

Attached hereto is a marked-up version of the changes made by the present amendment entitled "Version with Markings to Show Changes Made."

Respectfully submitted,

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JCH/SKS/VJB

**Version With Markings to Show Changes Made**

**In the claims:**

16. (Amended) A formulation [comprising] consisting essentially of

at least one EFA selected from the group consisting of: linolenic acid; gamma-linolenic acid; dihomogammalinolenic acid; arachidonic acid; adrenic acid; docosapentaenoic acid; alpha-linolenic acid; stearidonic acid; eicosatetraenoic acid (n-3); eicosapentaenoic acid; docosapentaenoic acid (n-3) and docosahexaenoic acid, and

at least one homocysteine-lowering agent selected from the group consisting of: vitamin B12; folic acid; [a compound related to folic acid biological activity similar to folic acid;] and vitamin B6[, and wherein there are no significant amounts of other micro-nutrients].